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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,716	01/09/2001	Holly Magna	PF-0420-2 DIV	8687

7590 02/14/2002

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EXAMINER
SAIDHA, TEKCHAND

ART UNIT	PAPER NUMBER
1652	4

DATE MAILED: 02/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/757,716	Applicant(s) MAGNA ET AL.	
	Examiner Tekchand Saidha	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 february, 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,10,14-16 and 27-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1,10,14-16 and 27-44* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1, drawn to human nucleotide pyrophosphohydrolase-2 (NTPPH-2), classified in class 435, subclass 195.

II. Claims 10 & 29-44, drawn to antibody, composition comprising the antibody and methods of use, classified in class 424, subclass 130.1.

III. Claims 14-16 & 28 drawn to a method of detecting a polynucleotide, classified in class 435, subclass 6.

IV. Claim 27, drawn to a method of screening compounds for altered expression of target polynucleotide, classified in class 435, subclass 69.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and group II are distinct because protein and antibody are chemically and biologically distinct molecules. Antibody and protein have fundamentally different molecular structure, each with its own set of functionality. Antibodies, for example are formed in the B-cells and are useful for binding to particular residues. Proteins do not function to bind in the particular immunological way that antibodies do, and therefore have different specificities for different substrates, and do not purport to have the kinds of specific activity that antibodies have.

3. Inventions of group I and group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). The protein of Group I can be used in a variety of ways

other than for method of hybridization by the invention of Group III. The protein can be used to find other inhibitors/activators that can be used in the treatment or diagnoses of certain illnesses. At the minimum the protein can be used to delineate molecular weight parameters in a protein gel electrophoresis assay. The inventions of group I and IV are also different for similar reasons i.e., the protein can used for the enzymatic formation of the product rather than in the method of assessing toxicity.

4. The Inventions of group II and group IV are independent and distinct because the antibody and a screening method to identify a compound are functionally distinct and neither requires the other to practice the invention.

5. Inventions II and III are patentably distinct from each other. The antibodies against the NTPPH-2 enzyme of Group II and the hybridization method requiring polynucleotide of Group III do not require each other for their practice; have separate utilities, structure and function. Invention of Group III and IV though use the same polynucleotide but are distinct because of separate utilities and distinct method steps. These groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Richard Ekstrom/Margerrette on 2.1.02 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Remarks:

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